REMARKS

The Applicant hereby traverses the current rejections and requests reconsideration and withdrawal of all rejections of record in light of the amendments and remarks contained herein. Claims 33-45 and claims 53-63 are pending in this application

Rejection under 35 U.S.C. § 112, second paragraph

Claims 53-58 currently stand rejected under 35 U.S.C. 112, second paragraph. Claim 53 recites the limitation "generating information identifying an image at a time said image is captured." The Examiner asserts that it is unclear "on who the information is generated and how will generates this information and whether the information is generated at the excite time of the image capturing or before or after the image is captured.... Dependent claims 54-58 inherit the deficiency from claim 53." (*see* Current Action, paragraph 3). The Applicant can best respond by pointing out that claim 53 has been amended to read "generating information identifying an image at the time said image is captured." The claims have been amended only for the purpose of complying with the requirements of 35 U.S.C. § 112, second paragraph, and not for the purpose of narrowing their scope in the face of prior art. No new matter has been entered.

As each element of indefiniteness cited by the Current Action has been addressed with a corresponding amendment, the Applicant respectfully requests the rejection of claims 53-58 under 35 U.S.C. §112, second paragraph be withdrawn.

Rejection under 35 U.S.C. § 103(a)

Claims 33-38, 40-45, 53-55, and 60-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,483,570 to Slater et al (hereinafter Slater) in view of U.S. Patent No. 6,629,104 to Parulski et al (hereinafter Parulski).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P.

§ 2143. Without conceding that the combination of Slater and Parulski meets any of the other requirements of M.P.E.P. § 2143, the Applicant respectfully points out that such combination fails to teach or suggest all of the claim limitations of Applicant's invention.

Claim 33 requires "using said camera to capture information associated with said image." In the Current Action, the Examiner relies on Parulski, at col. 2, lines 55-63, to teach this limitation (*see* Current Action, pg. 3). However, at this citation Parulski merely describes "prompting a user to create labels for their pictures prior to capturing any images for the purpose of locating the pictures at a later time." As such, Parulski does not teach or suggest using a camera to capture information associated with an image. Parulski describes "a method for adding personal image metadata to a collection of images...prior to image capture." (see Parulski col. 1, lines 60-67). As such, Parulski only describes "pre-assigned" metadata labels "allowing a user to preemptively categorize photos." (*see* Parulski col. 2, lines 1-10). Further, Slater does not teach or suggest, and is not relied upon to show, this missing limitation. Instead, Slater is a method and system utilized in the processing of images long after they are captured. Therefore, the combination of Slater and Parulski fails to satisfy the requirements of M.P.E.P. § 2143. The Applicant respectfully asks the Examiner to withdraw the 35 U.S.C. § 103(a) rejection of claim 33.

Claims 34-38 and 40-45 depend from claim 33, and thus inherit all limitations of claim 33. Each of claims 34-38 and 40-45 set forth features and limitations not recited by the combination of Slater and Parulski. Thus, the Applicant respectfully asserts that for at least the reasons set forth above with respect to claim 33, claims 34-38 and 40-45 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 53 requires "generating information identifying an image at the time said image is captured." In the Current Action, the Examiner contends this limitation is taught by Parulski, at col. 2, lines 28-38. (Current Action, pg. 6). However, this citation does not teach the limitations the Current Action contends, but merely contains a "Brief Description of the Drawings." Moreover, a review of the entire reference by the Applicant did not reveal any aspect of Parulski that teaches "generating information identifying an image at the time said image is captured." Instead, Parulski describes "a method for adding personal image metadata to a collection of images...prior to image capture." (see Parulski col. 1, lines 60-67).

As such, Parulski only describes "pre-assigned" metadata labels "allowing a user to preemptively categorize photos." (see Parulskie col. 2, lines 1-10). Further, Slater does not teach or suggest, and is not relied upon to show, this missing limitation. Instead, Slater is a method and system utilized in the processing of images long after they are captured. Therefore, the Applicant respectfully asks the Examiner to withdraw the 35 U.S.C. § 103(a) rejection of claim 53.

Claims 54-55 depend from claim 53, and thus inherit all limitations of claim 53. Each of claims 53-54 set forth features and limitations not recited by the combination of Slater and Parulski. Thus, the Applicant respectfully asserts that for at least the reasons set forth above with respect to claim 53, claims 54-55 are patentable over the 35 U.S.C. § 103(a) rejection of record.

As an initial matter, the Applicant notes that there is no rejection of record for claim 59. Claims 60-63 depend from claim 59, and thus inherit all limitations from claim 59. Therefore, claims 60-63 should be allowable by virtue of depending from an allowable independent claim. Nevertheless, the Applicant sets forth a specific response to the Examiner's rejection of claims 60-63 in an attempt to expedite prosecution of this application. Each of claims 60-63 require the limitation "automatically generating..., meta-data associated with each said image, ...wherein said meta-data for each said image is generated at a time said image is captured." As demonstrated above, the combination of Slater and Parulski fails to teach "meta-data generated at the time said image is captured." Instead, Slater is a method and system utilized in the processing of images long after they are captured. Further, Parulski does not teach or suggest, and is not relied upon to show, this missing limitation. Instead, Parulski describes "a method for adding personal image metadata to a collection of images...prior to image capture." (*see* Parulski col. 1, lines 60-67). As such, Parulski only describes "pre-assigned" metadata labels "allowing a user to preemptively categorize photos." (*see* Parulski col. 2, lines 1-10). Therefore, the combination of Slater and Parulski fails to satisfy the requirements of M.P.E.P. § 2143. The Applicant respectfully asks the Examiner to withdraw the 35 U.S.C. § 103(a) rejection of claim 60-63.

In the Current Action, the Examiner initially contends that claims 39 and 56-58 are rejected as being unpatentable over Slater in view of Parulski and further in view of U.S.

Patent No. 6,426,801 to Reed (hereinafter "Reed"). With respect to claim 39, the Applicant points out that the combination of Slater, Parulski, and Reed does not teach or suggest all of the limitations of claim 39. Claim 39 depends from claim 33, and thus inherits all of the limitations of claim 33, including "using said camera to capture information associated with said image." As demonstrated above, neither Slater or Parulski teach or suggest this limitation. Further, Reed does not teach or suggest, and is not relied upon to disclose, this limitation either. Therefore, the combination of Slater, Parulski, and Reed does not make a prima facie case of obviousness, and the Applicant respectfully requests the Examiner to withdraw the rejection of claim 39.

In subsequently referring to claims 56-58, the Examiner only mentions the combination of Slater and U.S. Patent No. 6,813,395 to Kinjo (hereinafter Kinjo). In view of this ambiguity, the Applicant respectfully requests that the Examiner make clear which combination is asserted against claims 56-58. With respect to claims 56-58, the Applicant can best respond by pointing out that the combination of Slater and Kinjo fails to teach or suggest all limitations of Applicant's claimed invention. Claims 56-58 depend from claim 53, and thus inherit all of the limitations of claim 53, including "generating information identifying an image at the time said image is captured." As demonstrated above, Slater does not teach or suggest this limitation. Further, Kinjo does not teach or suggest, and is not relied upon to disclose, this limitation either. Therefore, the combination of Slater and Kinjo does not make a prima facie case of obviousness, and the Applicant respectfully ask the Examiner to withdraw the rejection of claims 56-58.

Conclusion

The Examiner is thanked for the indication that claim 59 includes allowable subject matter.

In view of the above remarks, the Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10003824-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as Express Mail, Airbill No. EV629197376US in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date of Deposit: August 26, 2005

Typed Name: Laura Horton

Signature: Laura Horton

Respectfully submitted,

By _____
Michael A. Papalas
Reg. No.: 40,381
Date: August 26, 2005
Telephone No. (214) 855-8378